

32. (New) A membrane eraser according to Claim 26, wherein said rod shaped body comprises titanium.

33. (New). A membrane eraser according to Claim 26, wherein said hard inorganic fine-grains are fixed by a silicone base adhesive to said front tip.

REMARKS

In the Office Action of Paper No. 6, new corrected drawings were required incorporating the amendments set forth in the "Proposed Amendments to the Drawings" filed on January 17, 2001. Submitted herewith under separate cover is an amendment of the drawings replacing the drawings filed with the application with new formal drawings incorporating the amendments. A set of new formal drawings incorporating the amendments has also been sent to the Patent Office Official Draftsperson. It is respectfully submitted that the new formal drawings comply with the requirement for corrected drawings.

In the Office Action the Oath and Declaration was considered to be defective and a new Oath and Declaration was required.

Specifically, the Oath and Declaration was considered to be defective because it did not state that all errors being corrected arose without deceptive intention. However, in referring to page 7, lines 15 and 16 of the Oath and Declaration it can be seen that it actually does state that "[t]he aforementioned errors arose without any deceptive intention on the part of the applicant, the inventors, the assignee of the original patent, or their legal representatives." Thus, for this reason, it is respectfully submitted that the Oath and Declaration is not defective.

The Oath and Declaration was considered to be defective because the original Oath and Declaration was amended on January 17, 2001, correcting the spelling of the name of one inventor and changing the residence address of another inventor.

It is respectfully submitted that these types of amendments made to the Oath and Declaration do not change the Oath and Declaration to the extent that a substitute Oath and Declaration is required. MPEP § 602.01 specifically sets forth that a deficiency in the Oath or Declaration can be corrected by a supplemental paper such as an Application Data Sheet and a new Oath or Declaration is not necessary. Submitted herewith is an originally executed Oath and Declaration without the correcting amendments made to the Oath and Declaration filed with the application, and an Application Data Sheet correcting the incorrect information on the filed Oath and Declaration, i.e. the misspelled inventors name and the changed inventors address. It is respectfully submitted that the submission of the original Oath and Declaration and the Application Data Sheet eliminates the need for a substitute Oath and Declaration under MPEP § 602.01.

It is respectfully submitted that in view of the explanation provided above and in view of the original Oath and Declaration and Application Data Sheet submitted herewith, the Oath and Declaration of the application is not defective.

Claims 1-7, 9-15, and 21-25 were rejected under 35 USC § 251 as being an improper recapture of claimed subject matter surrendered in the application for patent upon which the present reissue application is based.

In the rejection it is contended that claim 1 of the original patent application was amended to recite "a hollow tapered front tip" and "grains are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip" to overcome an anticipation rejection in view of the U.S. Patent of Shimizu No. 3,809,101. It is also contended that an argument was presented that the Shimizu patent does not disclose the two features cited above, and therefore amended claim 1 was defined over Shimizu. The rejection states that the omission of the features quoted above from independent claims 1, 9, 12 and 21 of the present application presents an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue application is based.

It is respectfully submitted that the above set forth recount of the prosecution history of the patent upon which the present reissue application is based is not accurate. Claim 1 was amended to recite "a hollow tapered front tip" and "said grains are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip" among other amendments made to the claim. However, the argument distinguishing the Shimizu reference stated that the subject matter claimed was "clearly distinguished from the nail file filing an individual's nails as shown in Shimizu which neither comprises a hollow tapered front tip of an elastic body nor does the same teach limiting the location of the grains to the range presently claimed and instead teaches only the utilization of an abrasive sheet 9 which extends substantially the entire length of the holding member". There is no mention of the specific 0.5 mm to 3.0 mm range in the argument distinguishing the Shimizu reference. Thus, there is no evidence in the prosecution history that the specific range of 0.5 mm to 3.0 mm was added to claim 1 to distinguish the subject matter claimed from Shimizu. The only evidence provided by the REMARKS portion of the amendment states that Shimizu neither comprises a hollow tapered front tip nor teaches limiting the location of the grains to a range.

"Reissued claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule." In re Clement, 131 F. 3d. 1464, 1470, 45 U.S.P.Q. 2d 1161, 1165 (Fed. Cir. 1997).

The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable. Seattle Box Co. v. Industrial Crating and Packaging, Inc., 731 F. 2d 818, 826, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).

There is no evidence presented that the limitation of 0.5 mm to 3.0 mm was added to claim 1 of the original patent application to avoid the Shimizu reference. Claim 1 was sufficiently amended to include the limitation of the grains being located in a range from an end

portion of the front tip to distinguish the subject matter of the invention from the Shimizu reference. As set forth in the REMARKS, the Shimizu nail file did not teach limiting the location of the grains to the range, but instead teaches only the utilization of an abrasive sheet which extends substantially the entire length of the holding member of the nail file. Thus, it is not necessary that the independent claims of the reissue application include in their limitations the specific 0.5 mm to 3.0 mm range.

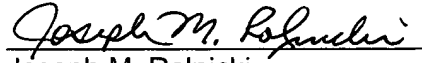
Claim 1 of the application has been amended herein to include the limitation of the fine-grains being located in a range from an end portion of the tip. Claim 9 has been amended herein to include the fine-grains being located in a range from an end portion of the tip. Claim 12 has been amended herein to include the limitation of the elastic body having a hollow, generally tubular shape, and the fine-grains being located in a range on said distal end portion of the elastic body. Claim 21 has been amended herein to include the limitations of a flexible tapered tip and the fine-grains being fixed to the elastic portion of the tool located in a range from an end portion of the tapered tip.

It is respectfully submitted that with the amendments of claims 1, 9, 12 and 21 presented herein, the claims are in conformance with 35 USC 251 and are allowable.

New claims 26-33 have been added by this amendment. Of the new claims, claim 26 is the only independent claim. Claim 26 conforms to the language of claim 1 of the issued Patent No. 5,921,998 except for the word "hollow" in describing the tapered front tip and the words "of 0.5 mm to 3.0 mm" in describing the range of the fine-grains. These features are included in the dependent claims of claim 26. For the reasons set forth above, it is respectfully submitted that new claims 26-33 are also allowable.

It is respectfully submitted that in view of the amendments and remarks presented herein, the application is in condition for allowance and favorable action is requested.

Respectfully submitted,



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CLAIMS AS AMENDED

B1

1. (Twice Amended) A membrane eraser used for ophthalmic surgery, comprising:
a grip portion;
a rod shaped body having opposite first and second ends, said first end being attached to said grip portion, said second end extending away from said grip portion;
an elastic body having opposite proximal and distal ends and a hollow interior, said hollow interior at said proximal end receiving said second end of said rod shaped body, said distal end having a tapered tip extending away from said rod shaped body; and
a plurality of hard, fine-grains fixed on said tapered tip of said elastic body, said fine-grains being located in a range from an end portion of said tip, said fine-grains being configured for removal of membrane tissue on a retina of an individual.

2. (Cancelled without prejudice).

5. (Cancelled without prejudice).

6. (Cancelled without prejudice).

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9. (Twice Amended) An ophthalmic treatment tool comprising:
a grip;
a rod shaped body having opposite first and second ends, said first end attached to said grip, said second end extending away from said grip;
an elastic body attached to said second end of said rod shaped body, said elastic body having a tapered tip extending away from said rod shaped body;
a plurality of hard, fine-grains fixed on said tapered tip of said elastic body, said fine-grains being located in a range from an end portion of said tip; and

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said elastic body has a general cylindrical shape with opposite proximal and distal ends and a hollow interior, said proximal end is fitted onto said second end of said rod shaped body, said distal end is cut on a bevel forming said tapered tip.

B3
12. (Twice Amended) An ophthalmic treatment tool comprising:
a grip;
a rod shaped body having opposite first and second ends, said first end attached to said grip, said second end having a slender line portion extending away from said grip;
an elastic body having a hollow, generally tubular shape with opposite proximal and distal ends, said proximal end having an opening receiving said slender line portion therein, said second end being spaced from said slender line portion and extending to a distal end having a taper; and
a plurality of hard, fine-grains fixed on said distal end of said elastic body, said fine-grains being located in a range on said distal end portion.

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21. (Amended) An ophthalmic membrane eraser comprising:
a tool having a length with opposite proximal and distal ends, a rigid portion of the tool adjacent the tool proximal end and an elastic, flexible tapered tip portion of the tool adjacent the tool distal end, the elastic portion of the tool is attached to the rigid portion of the tool and projects from the rigid portion of the tool for a portion of the length of the tool to the tool distal end, the elastic portion of the tool has a tapered tip at the tool distal end; and
a plurality of hard, fine-grains fixed to the elastic portion of tool, the fine-grains are fixed to the elastic portion of the tool only located in a range from an end portion of the tapered tip and are absent from a remainder of the elastic portion of the tool so as not to detract from the flexibility of the remainder of the elastic portion of the tool.

26. (New) A membrane eraser used for ophthalmic surgery, comprising:
a grip portion;
a rod shaped body attached to one end of said grip portion;
an elastic body fitted along a direction toward a front end of said rod shaped body to the front end side thereof and having a tapered front tip; and,
a plurality of hard, inorganic fine-grains fixed on said tapered front tip of said elastic body wherein said grains are located in a range from an end portion of said front tip for removal of membrane tissue on a retina of an individual.

27. (New) A membrane eraser according to Claim 26, wherein said fine-grains are located in a range of 0.5 mm to 3.0 mm.

28. (New) A membrane eraser according to Claim 27, wherein said tapered front tip is hollow.

29. (New) A membrane eraser according to Claim 26, wherein said elastic body comprises silicone rubber.

30. (New) A membrane eraser according to Claim 26, wherein said hard inorganic fine-grains comprise grains having a range in diameter from 3 to 80 μm .

31. (New) A membrane eraser according to Claim 26, wherein said hard inorganic fine-grains comprise diamond particles.

32. (New) A membrane eraser according to Claim 26, wherein said rod shaped body comprises titanium.

33. (New). A membrane eraser according to Claim 26, wherein said hard inorganic fine-grains are fixed by a silicone base adhesive to said front tip.
